

**REMARKS/ARGUMENTS**

Upon entry of the present amendment, claims 20, 28, and 29 will have been amended for consideration by the Examiner. Thus, claims 20-29 remain pending. In view of the herein-contained remarks, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejections of all the claims pending in the present application. Such action is respectfully requested and is now believed to be appropriate and proper.

Initially, Applicant would like to express his appreciation to the Examiner for the detailed Official Action provided.

Turning to the merits of the action, the Examiner has rejected claims 20- 21, and 24-29 under 35 U.S.C. § 103 (a), as being unpatentable over FUJIOKA (JP 11-301058) in view of MURATA (U.S. Patent No. 5,673,119) and WADA (JP 09-233248). The examiner also has rejected claim 23 under 35 U.S.C. § 103 (a), as being unpatentable over FUJIOKA (JP 11-301058) in view of MURATA (U.S. Patent No. 5,673,119) and WADA (JP 09-233248).

Applicant respectfully traverses the above rejection based on pending claims 20-29 and will discuss said rejection with respect to the pending claims in the present application as will be set forth hereinbelow.

Applicant's claims 20-28 generally relate to a multifunction apparatus which includes a printer which prints the image data stored in the memory.

Further, a controller predicts an amount of the obtained image data compressed by the compression method utilized for the facsimile communication, based on at least a size of a recording paper and a predetermined compression rate utilized in the compression method, before storing the compressed image data in the memory, judges whether the predicted amount of the compressed image data can be stored in the memory. Claim 29 recites a generally related method.

To the contrary, as the Examiner affirms in the outstanding Official Action on August 25, 2004, FUJIOKA and MURATA do not disclose at least the claimed controller configured to predict an amount of the image data compressed by the compression method utilized for the facsimile communication before storing the compressed image data in the memory and to judge whether the predicted amount of the compressed image data can be stored in the memory. Thus, the features of the pending claims are clearly distinguished over the combination of FUJIOKA and MURATA.

Further, MURATA relates to an encoding processing apparatus utilized for a scanning and transmission operation. The encoding processing apparatus input scanned data or PDL data for transmission. However, MURATA does not teach a printing operation. Thus, MURATA does not disclose predicting an amount of the compressed image data for printing, based on at least a size of a recording paper and a predetermined compression rate utilized in the compression method. Thus, MURATA also does not disclose at least the claimed controller configured to

predict an amount of the image data compressed by the compression method utilized for the facsimile communication, based on at least a size of a recording paper and a predetermined compression rate utilized in the compression method, before storing the compressed image data in the memory, and to judge whether the predicted amount of the compressed image data can be stored in the memory.

Therefore, it is respectfully submitted that the features recited in Applicant's independent claims 20, 28, and 29 are not disclosed in any proper combination of FUJIOKA and MURATA cited by the Examiner.

Further, WADA relates to a scanning operation of a facsimile apparatus in which an amount of compressed image data is predicted for scanning image data, based on a size of a transmitting document, a density of scanning lines, and a scanning mode (see. paragraphs 0013 and 0019).

However, with respect to a printer, WADA merely teaches the general configuration of a plotter 6, but neither teaches or suggests a printing operation nor PDL data. WADA also does not disclose predicting an amount of the compressed image data for printing, based on at least a size of a recording paper and a predetermined compression rate utilized in the compression method. Thus, WADA does not disclose at least the claimed controller which configured to predict an amount of the image data compressed by the compression method utilized for the facsimile communication, based on at least a size of a recording paper and a predetermined compression rate utilized in the compression method, before storing

the compressed image data in the memory, the image data being printed, and to judge whether the predicted amount of the compressed image data can be stored in the memory.

Further, the features of the present invention relate to a printing operation, while the features of WADA relate to a scanning operation, a non-analogous art. In other words, the pending claims predict an amount of compressed data in a printing operation, while WADA predict an amount of compressed data in a scanning operation. Thus, at least with respect to a type of data on which the prediction bases, the pending claims are clearly distinguished over WADA.

Therefore, it is respectfully submitted that the features recited in Applicant's independent claims 20, 28, and 29 are not disclosed in WADA cited by the Examiner. Thus, the features of the pending independent claims are clearly distinguished over the Examiner's proposed combination of FUJIOKA, MURATA, and WADA, since none of FUJIOKA, MURATA, and WADA do not disclose the above features recited in any of the pending independent claims. Thus, the pending independent claims are submitted to be patentable over the Examiner's proposed combination.

Moreover, the Examiner has not set forth a proper motivation for combining FUJIOKA and MURATA with WADA, since FUJIOKA and MURATA relate to the PDL data, while MURATA does not relate to the PDL data, as explained above. Specially, PDL data has a structure which has a plurality of layers. Thus, an

amount of the PDL data can not be predicted. On the other hand, WADA disclose predicting an amount of scanned image data, based on the size of the transmitting document, the density of scanning lines, and the scanning mode, as explained above. Thus, the Examiner has not set forth a proper motivation for combining FUJIOKA and MURATA, which relate to PDL data, with WADA which merely discloses predicting an amount of scanned image data. Rather, the Examiner has, based upon Applicant's disclosure, picked various individual features of the references and has combined them in the manner taught by Applicant's disclosure. This hindsight reconstruction is inappropriate under 35 U.S.C. § 103.

Also with respect to dependent claims 21-27, since these claims are dependent from allowable independent claim 20, which is allowable for at least the reasons discussed supra, these dependent claims are also allowable for at least these reasons. Further, these dependent claims recite additional features which further define the present invention over the references of record.

Further, with respect to claim 23, the Examiner assert that “in the FUJIOKA-MURATA-WADA combination, the compressor in the communication section is not restricted to using a minimum compression rate when the controller predicts the amount of the compressed image data. However, it is well known in the art to adjust the compression rate based on the predicted amount of the compressed image data...” Applicant respectfully submits that this assertion is entirely without support and requests that the Examiner cite at least one reference

in support of this assertion (together with a proper motivation to combine it with the FUJIOKA-MURATA-WADA combination), if the Examiner chooses to maintain this rejection.

Further, Applicant asserts that the amendment to the claims does not raise new issues that require the Examiner to conduct an additional search. The present amendment has merely more clearly defined the present claimed invention.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejections and an indication of the allowability of all the claims pending in the present application in due course.

### **SUMMARY AND CONCLUSION**

Applicant has made a sincere effort to place the present application in condition for allowance and believes that he has now done so. Applicant has amended the rejected claims for consideration by the Examiner. Accordingly, Applicant has provided a clear evidentiary basis supporting the patentability of all claims in the present application and respectfully requests an indication of the allowability of all the claims pending in the present application in due course.

Applicant notes that this amendment is being made to advance prosecution of the application to allowance, and with respect to the claimed features argued as deficient in the prior art, should not be considered as surrendering equivalents of the territory between the claims prior to the present amendment and the amended claims. Further, no acquiescence as to the propriety of the Examiner's rejection is made by the present amendment. All other amendments to the claims which have been made in this amendment, and which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

Should the Examiner have any questions or comments regarding this Response, or the present application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,  
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